

REMARKS

This is a full and timely response to the outstanding final Office Action mailed May 13, 2004. Upon entry of the amendments in this response, claims 1-4, 9-20 and 22-30 remain pending. In particular, Applicants have amended claims 1-4, 9-11, 14, 15, 18 and 19. Claims 5-8 and 21 have been canceled without prejudice, waiver, or disclaimer. Claims 22-30 are newly added. Applicants reserve the right to pursue the subject matter of the canceled claims in a continuing application, if Applicants so choose, and do not intend to dedicate the canceled subject matter to the public. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

A. Rejection of claims 1 – 13, and 21 under 35 U.S.C. §102

a) Statement of the rejection

The Office Action states: “*Claims 1 – 13, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Anderson et al. (U.S. Patent No. 6,026,506 and Anderson hereinafter).*”

b) Response to the rejection

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice. *See, e.g., Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). The test is the same for a process. Anticipation requires identity of the claimed process and a process of the prior art. The claimed process, including each step thereof, must have been described or embodied, either expressly or inherently, in a single reference. *See, e.g., Glaverbel S.A. v. Northlake Mkt'g & Supp., Inc.*, 45 F.3d 1550, 33 USPQ2d 1496 (Fed. Cir. 1995). Those elements must either be inherent or disclosed expressly. *See, e.g., Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). Those

elements must also be arranged as in the claim. *See, e.g., Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989); *Carella v. Starlight Archery & Pro Line Co.*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

Accordingly, the single prior art reference must properly disclose, teach or suggest each element of the claimed invention. Provided below are the responses for each of the claims 1 – 13, and 21 that have been rejected under 35 U.S.C. §102(e).

Claim 1

The Office Action alleges that Anderson discloses, in pertinent part, “assigning a unique designator to the source of the at least one packetized data stream (i.e., PID)(Col. 3, lines 65-67 and Col. 4, lines 1-5).”

In this connection, attention is drawn to Applicants’ specification (page 11, lines 5 – 9), which states, in accordance with one exemplary embodiment:

“The unique designator is not to be confused with a packet identifier (PID). The PID is associated with the packet and identifies all packets with the same type of data associated with a particular program or service. For example, the video packets associated with the television program for channel 12 will all have the same PID. The unique identifier of the present invention is associated with the source of the portion of the multiplexed signal for the packetized data.”

(Emphasis added).

Clearly, Applicants have made an effort to clarify that their “unique identifier” is not the same as a PID, and have provided, in Applicants’ specification, details of the nature and usage of this “unique identifier.” Consequently, Applicants respectfully assert that Anderson does not disclose Applicants’ “unique identifier,” and therefore, claim 1 is allowable.

Applicants further submit that the Office Action rejection of claim 1 under 35 U.S.C. §102(e) is improper because the cited prior art fails to properly disclose, teach or suggest each element of Applicants’ claim 1. Specifically, Anderson fails to disclose at least, “assigning to the source of the at least one packetized data stream, a first unique identifier.”

Additionally, Anderson further fails to disclose “*transmitting the first unique designator in conjunction with the multiplexed signal, wherein the first unique designator indicates the source of the at least one packetized data stream.*” In this connection, Anderson discloses in his Col. 4, lines 31 – 32, that “*The PID field data is used to collect the packets of a stream and reconstruct the stream.*” The definition of Anderson’s “PID field data” is distinguishably different from Applicants’ “unique designator.” Therefore, Applicants respectfully submit that the Office Action rejection of claim 1 under 35 U.S.C. §102(e) is improper.

In conclusion, Applicants respectfully request withdrawal of the rejection of claim 1 for at least the above-mentioned reasons, followed by allowance of the claim.

Claims 2 - 4

Claims 2 - 4 depend on currently amended claim 1. Applicants respectfully assert that currently amended claim 1 is allowable. Because independent claim 1 is allowable, claims 2 - 4 that depend directly on claim 1 are also allowable as a matter of law. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Consequently, Applicants respectfully request that rejection of claims 2 - 4 under 35 U.S.C. 102(e) be withdrawn, followed by allowance of claims 2 - 4.

Claims 5 - 8

Claims 5 – 8 have been canceled without prejudice, waiver, or disclaimer, thereby rendering moot the rejection under 35 U.S.C. §102(e), of claims 5 – 8.

Claim 9

The Office Action alleges that Anderson discloses, in pertinent part, “assigning a unique designator to each originating packetized data stream of the at least two packetized data streams (i.e., PID)(Col. 3, lines 65-67 and Col. 4, lines 1-5)...” The differences between Anderson’s PID and Applicants’ “unique identifier,” have been discussed above, and in the interests of brevity will not be repeated here.

Applicants respectfully submit that the Office Action rejection of claim 9 under 35 U.S.C. §102(e) is improper because the cited prior art fails to properly disclose, teach or suggest each element of Applicants’ claim 9. Specifically, Anderson fails to at least disclose, “*assigning to each of the sources originating the at least two packetized data streams, associated unique identifiers.*”

Additionally, Anderson further fails to disclose “decrypting, in the external conditional access module, the packets in the signal based on the associated unique identifiers.”

This is in contrast to Anderson, wherein is disclosed in Col. 4, lines 31 – 32, “*The PID field data is used to collect the packets of a stream and reconstruct the stream.*”

For at least the above-mentioned reasons Applicants respectfully reiterate that the Office Action rejection of claim 11 under 35 U.S.C. §102(e) is improper, and consequently request withdrawal of the rejection of claim 9 followed by allowance of claim 9.

Claim 10

Claim 10 depends on currently amended claim 9. Applicants respectfully assert that currently amended claim 9 is allowable. Because independent claim 9 is allowable, claim 10 that depends directly on claim 9 is also allowable as a matter of law. *In re Fine*, 837 F. 2d 1071 (Fed. Cir. 1988). Consequently, Applicants respectfully request that rejection of claim 10 under 35 U.S.C. 102(e) be withdrawn, and that claim 10 be placed in allowance.

Claim 11

The Office Action alleges that Anderson discloses, in pertinent part, “assigning a unique designator to the source of the first MPEG-2 transport stream, creating a transport stream source indicator signal that includes the unique designator associated with the at least one packet of the first MPEG-2 transport stream (i.e., PID)(Col. 3, lines 65-67 and Col. 4, lines 1-5)...” The differences between Anderson’s PID and Applicants’ “unique identifier,” have been discussed above, and in the interests of brevity will not be repeated in this response to the rejection of claim 11.

Applicants respectfully assert that at least the above-mentioned parts of Applicants’ claim 11 are not disclosed in the cited prior art. Therefore, Applicants respectfully reiterate that the Office Action rejection of claim 11 under 35 U.S.C. §102(e) is improper, and hereby request withdrawal of the rejection of claim 11, followed by allowance of claim 11.

Claims 12 - 13

Claims 12 - 13 depend, directly or indirectly, on currently amended claim 11. Applicants respectfully assert that currently amended claim 11 is allowable. Because independent claim 11 is allowable, claims 12 - 13 that depend directly or indirectly, on claim 11 are also allowable as a matter of law. *In re Fine*, 837 F. 2d 1071 (Fed. Cir. 1988). Consequently, Applicants respectfully

request that rejection of claims 12 –13, under 35 U.S.C. 102(e) be withdrawn, followed by allowance of claims 12 - 13.

Claim 21

Claim 21 has been canceled without prejudice, waiver, or disclaimer, thereby rendering moot the rejection under 35 U.S.C. §102(e), of claim 21.

B. Rejection of claims 14 – 20 under 35 U.S.C. §103

a) Statement of the rejection

The Office Action states: “*Claims 14 – 20 are rejected under 35 U.S.C. 103(a) as being anticipated over Anderson et al. (U.S. Patent No. 6,026,506 and Anderson hereinafter), in view of Banker et al., (U.S. Patent No. 5,485,221 and Banker hereinafter).*”

b) Response to the rejection

Applicants respectfully assert that the Office Action fails to establish a *prima facie* case of obviousness in rejecting claims 14 – 20. The relevant MPEP guideline, in pertinent part, is reproduced below:

MPEP 706.2(j) Contents of a 35 U.S.C. 103 Rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria. (Emphasis added)

Claim 14

With reference to the first of the three basic criteria mentioned above, it is unfortunate that the Office Action fails to indicate where in the cited prior art is present, “**some suggestion or motivation to modify the reference or to combine reference teachings.**” The Federal Circuit has repeatedly stated, “Modification unwarranted by the disclosure of a reference is improper.” *Carl Schenck, A.G, v. Nortron Corp.*, 713 F.2d 782, 218 U.S.P.Q. 698, 702 (Fed. Cir. 1983). In this regard, “[t]he mere fact that the prior art may be modified in the manner suggested by the [Office

action] does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780 (Fed Cir. 1992).

Every invention contains a recitation of elements. Many inventions can be categorized as a new combination of well-known elements. When new combinations are analyzed on an element-by-element basis, each of the elements may already be known. If merely proving that each element of a pending claim were well-known was enough to render the claim obvious, nothing would be patentable.

In the present rejection, the Office Action alleges that Anderson discloses all the elements of Applicants’ claim 14, except that “Anderson does not expressly disclose determining if decryption is allowed for the data packet,” and further goes on to state that “it would have been obvious to a person of ordinary skill in the art at the time of Applicants’ invention to modify the teachings of Anderson with the teachings of Banker because it would allow to include a controller for determining if decryption is allowed...” Applicants have reviewed the Anderson patent and can find *no evidence of a suggestion or motivation* to combine the teachings of Anderson with the teachings of Banker. Because, a *prima facie* case of obviousness is established only when there is proper motivation to substitute, modify, or add the particular missing element from a first reference with the element as found in the second reference, Applicants submit that the Office Action has failed to establish a proper *prima facie* case of obviousness in rejecting claim 14.

Attention is now drawn to the third of the three basic criteria mentioned above, wherein is stated, “the prior art reference(s) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicants’ disclosure.” In this connection, attention is drawn to the Office action assertion that “Anderson discloses an external access module that can decrypt, based on a unique designator that indicates a source of a data packet, data packets from at least one packetized data stream within an incoming multiplexed signal comprised of data packets...” (Emphasis added). Applicants respectfully submit that Anderson does not disclose such a decryption based on “a unique designator that indicates a source of a data packet.” Consequently, it is respectfully asserted that the rejection of claim 14 under 35 U.S.C. 103(a) is improper.

Withdrawal of the rejection of claim 14 is hereby requested followed by allowance.

Claims 15 - 17

Claims 15 - 17 depend, directly or indirectly, on currently amended claim 14. Applicants respectfully assert that currently amended claim 14 is allowable. Because independent claim 14 is allowable, claims 15 - 17 that depend directly or indirectly, on claim 14 are also allowable as a matter of law. *In re Fine*, 837 F. 2d 1071 (Fed. Cir. 1988). Consequently, Applicants respectfully request that rejection of claims 15 - 17, under 35 U.S.C. 103(a) be withdrawn, followed by allowance of claims 15 - 17.

Claim 18

The Office Action fails to establish a *prima facie* case of obviousness while rejecting independent claim 18. The criteria for such a rejection has been outlined above, and in the interests of brevity, will not be repeated here. In this rejection, the Office Action alleges that Anderson discloses all the elements of Applicants' claim 18, except that "Anderson does not expressly disclose multiple tuners." This allegation is followed by: "it would have been obvious to a person of ordinary skill in the art at the time of Applicants' invention to modify the teachings of Anderson with the teachings of Banker because it would allow to include a host terminal comprising at least two tuners..." Applicants have reviewed the Anderson patent and can find *no evidence of a suggestion or motivation* to combine the teachings of Anderson with the teachings of Banker.

Attention is now drawn to the third of the three basic criteria mentioned above, wherein is stated, "the prior art reference(s) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicants' disclosure." In this connection, attention is drawn to the Office action assertion that "*Anderson discloses...a multiplexer for combining data packets from at least two packetized data streams into the multiplexed signal, for assigning a unique indicator that indicates **which tuner received** the packetized data stream...*" (Emphasis added). Applicants respectfully submit that Anderson does not disclose such a multiplexer incorporating the "indicates which tuner received the packetized data stream," aspect that is referred to above. Consequently, it is respectfully asserted that the rejection of claim 18 under 35 U.S.C. 103(a) is improper.

Withdrawal of the rejection of claim 18 is hereby requested followed by allowance.

Claims 19 - 20

Claims 19 - 20 depend on currently amended claim 18. Applicants respectfully assert that currently amended claim 18 is allowable. Because independent claim 18 is allowable, claims 19 – 20 that depend directly on claim 18 are also allowable as a matter of law. *In re Fine*, 837 F. 2d 1071 (Fed. Cir. 1988). Consequently, Applicants respectfully request that rejection of claims 19 - 20, under 35 U.S.C. 103(a) be withdrawn, followed by allowance of claims 19 - 20.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-4, 9-20 and 22-29 are in condition for allowance. Although some dependent claim rejections and some obviousness rejections are explicitly addressed above, the omission of arguments for other claims is not intended to be construed as an implied admission that the Applicants agree with the rejection or finding of obviousness for the respective claim or claims. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned Attorney at (770) 933-9500.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "George M. Thomas", is written over a horizontal line.

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